

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/549,685
Applicant : Eva CAROFF et al.
Filed : September 19, 2005
Title : GUANIDINE DERIVATIVES AND THEIR USE AS NEUROPEPTIDE FF RECEPTOR ANTAGONISTS
TC/Art Unit : 4161
Examiner: Manohar, Manu M
Docket No. : 66535.000004
Customer No. : 21967

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Applicants provide the following remarks in response to the Restriction Requirement mailed June 9, 2008, in the above-captioned application.

The Restriction Requirement sets forth the following allegedly distinct inventions:

- Group I:** Claims 1-7, 19 and 20, drawn to a method of use;
- Group II:** Claims 8-18, drawn to compound and compositions; or
- Group III:** Claim 21, drawn to method of making.

The Examiner alleges that claims 1, 18, 19 and 21 are generic. Furthermore, the Examiner alleges that the application contains claims directed to more than one species of the generic invention. An election of species is required by the Examiner as follows:

- If Group I is elected, also select an exact definition of each substitution on the base molecule (structures defined) wherein a single member of each substituent group or moiety is selected (*i.e.*, Formula I for A elect one of a specific group like methyl or phenyl.)
- If Group II is elected, also select a single compound including an exact definition of each substitution on the base molecule (structures defined) wherein a single member of each substituent group or moiety is selected.
- If Group III is elected, an election is required being specific to a compound or group of compounds with the base structure defined.

In order to be responsive to the restriction requirement, Applicant hereby elects Group II, claims 8-18. Applicant further elects as a species N-[6-(3,4-Dimethoxy-phenyl)-4,5,6,7-tetrahydro-bezothiazol-2-yl]-guanidine). Applicant hereby makes this election *with traverse*. Applicant disputes the allegation that the claimed compounds “do not contribute over the prior art.” It is unclear from the text of the Office Action whether the examiner considers the claims to be anticipated or obvious in view of the cited references. Applicant would point out that the elected claims recite compounds having a particular chemical structure with specific exceptions. The Restriction Requirement fails to set forth any specific findings as to how the particular claimed compounds are anticipated or obvious in view of the cited prior art. Finally, applicant

respectfully requests rejoinder of the non-elected species in the event that a generic claim is found allowable.

CONCLUSION

In view of the above remarks, early notification of a favorable consideration is respectfully requested.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: July 7, 2008

By:


Jeff E. Vockrodt
Registration No. 54,833

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)